

## **REMARKS**

Reconsideration of the subject application in view of the foregoing amendment is respectfully requested.

By the present amendment, claims 1 and 5 have been amended.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

The Examiner rejected Claims 1 through 6 under 35 U.S.C. §103(a) as being unpatentable over Gerritsen, U.S. Patent No. 5,421,091 (Gerritsen) in view of Hall, U.S. Patent No. 2,663,291 (Hall). Claims 7-8 were rejected respectively under 35 U.S.C. §103(a) as being unpatentable as claims 1-6 above and further in view of Osada, U.S. Patent No. 6,523,267 (Osada) and Smolinski, U.S. Patent No. 5,992,540 (Smolinski). Claim 9 was rejected as claims 1-6 above and further in view of Stowell, U.S. Patent No. RE 37,190 (Stowell). It is respectfully submitted that claims 1-9 are patentable over the cited references.

Specifically, claim 1 recites an adjusting device (30) mountable on the housing connecting means (16) for securing the connection means (21) to the

housing, and a rectilinear spring member (36) for biasing the adjusting device (30) to its locking position and extending substantially parallel to a longitudinal direction of the housing neck (8). Claim 1 also recites that all of the support regions of the adjusting device on the housing and the housing have a common release direction (E).

It is respectfully submitted that the saber saw recited in Claim 1 is not disclosed or suggested in the prior art including all of the prior art of record in this application. Considering the prior art, Gerritsen does not disclose a rectilinear spring member for biasing the adjusting device, as it is recognized in the Office Action. Nor does Gerritsen disclose that all of the support regions of the adjusting device on the housing and the housing have a common release direction.

It is noted that Gerritsen is discussed in detail in the preamble of the specification. As it is discussed there, the locking plunger (45) is displaceable transverse to a longitudinal extent of the guide rail, i.e., transverse to the longitudinal extent of the saw housing.

The plunger (45) is located between two housing parts (12, 14) with two release directions at least one of which would be different from the release direction of the support regions of the plunger (45).

Further, assuming, *arguendo*, that Gerritsen is combined with Hall, the rectilinear spring member would necessarily extend transverse to the longitudinal direction of the housing, i.e., of the housing neck.

However, as it has been discussed in the previous amendment, a case of a *prima facie* has not been made. Applicant believes it would be superfluous to repeat here all the arguments and reference to authorities which were set forth in the previous amendment.

The Examiner asserts that it would have been obvious to use of the spring of Hall in order to allow the actuation element (the Examiner apparently means “adjusting element”) to be located at

“a location other than directly underneath or above the adjusting element thereby allowing a manufacturer to place the actuation element at a place along the handle of the saw that would be more economic and easier to use.”

Applicant respectfully submits that such modification of Gerritsen is not suggested by the prior art and could be obvious only from the applicant’s own disclosure.

The Court of Appeals for Federal Circuit clearly stated that a modification of a prior art reference would not be obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

This decision of the Court of Appeals for Federal Circuit is consistent with the decision in *National Tractor Pullers Assoc., Inc. v. Watkins*, 205 U.S.P.Q. 892 (D.C. NJ 1980) in which the Court held that the

test of obviousness under 35 U.S.C. 103 is not whether prior art device could be modified into something resembling applicant's structure, but whether, at time invention was made, it would have been obvious to person of ordinary skill in art, given teachings of prior art, to make the invention; in considering prior art, prior patents are references only for what they clearly disclose or suggest, and it is not proper to modify their structures in manner that is not suggested by prior art (emphasis added).

The Board of Patent Appeals and Interferences likewise stated that prior art must provide motivation or reason for worker in said art to make necessary changes in reference device, without benefit of appellant's specification, in order to be obvious. *Ex parte Chicago Rawhide Manufacturing Co.* (PO Bd. App. 1984) 223 U.S.P.Q. 351.

It is respectfully submitted that obviousness of the present invention over the combination of Gerritsen and Hall can be gleaned only from a hindsight reconstruction.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in Uniroyal v. Redkin-Willey, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

Nothing in the prior art suggests the desirability of the combination set forth in the Office Action. The same Court further stated:

. . . it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention.

It is noted that the Examiner asserts that a reference is relevant if a document with a certain feature can be found in relevant search class, irrespective of the nature of the document. Applicant is not aware of any authority that would have supported this position of the Examiner.

In case the relevance of Hall is asserted further, the Examiner is respectfully requested to cite an appropriate authority.

In view of the above, it is respectfully submitted that claim 1 patentably defines over the prior art, including Gerritsen and Hall, and is allowable.

Claims 2 and 4-9 depend on claim 1 and are allowable as being dependent on an allowable subject matter.



## CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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